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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,835	10/19/2001	Alex S. Taylor	110914	7065
27074	7590	09/08/2004	EXAMINER	
OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			RIES, LAURIE ANNE	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/981,835	TAYLOR ET AL.	
	Examiner	Art Unit	
	Laurie Ries	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/31/2002</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

- Page 3, line 7 – “The processor comprises 16” should read “The processor 16 comprises”

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 9, 10, 11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (U.S. Publication 2004/0088332 A1).

As per claims 1 and 9, Lee discloses a system and method for processing a target document that includes a storage device for storing a number of words (See Lee, Page 11, paragraphs 0136-0137), a search device to identify whether any of the words present in the storage device are present in the target document (See Lee, Page 11, paragraph 0139), and an annotation device to

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annotate the words located in the target document (See Lee, Page 11, paragraph 0138-0139).

As per claims 2, 10 and 11, Lee discloses an input device to input words from a source document into the storage device (See Lee, Page 11, paragraph 0137), which includes a detector for detecting one or more annotated regions or words in the source document (See Lee, Page 15, paragraph 0177), and a device for entering the regions into the storage device. (See Lee, Page 15, paragraph 0178).

As per claim 13, Lee discloses detecting annotations in a captured image of the source document. (See Lee, Page 12, paragraph 0148).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 7, 8, 12, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Publication 2004/0088332 A1) as applied to claims 1, 2, 9 and 10 above, and further in view of Evans (U.S. Patent 6363179 B1).

As per claims 3 and 12, Lee discloses the limitations of claims 2 and 10 above. Lee does not disclose expressly optically capturing a digital image of a

physical source document. Evan discloses using an OCR device to capture a document image. (See Evans, Column 4, lines 48-58). Lee and Evans are analogous art because they are from the same field of endeavor of processing digital documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the optical image capture of Evans with the system and method of Lee. The motivation for doing so would have been to be able to identify characters in the document text by means of their coordinates and offsets. (See Evans, Column 4, lines 28-48). Therefore, it would have been obvious to combine Evans with Lee for the benefit of identifying individual characters within a document to obtain the invention as specified in claims 3 and 12.

As per claim 4, Lee and Evans disclose the limitations of claim 3 above. Lee also discloses detecting annotations in a captured image of the source document. (See Lee, Page 12, paragraph 0148).

As per claims 7 and 16, Lee discloses the limitations of claims 1 and 9 as described above. Lee does not disclose expressly optically capturing a digital image of a physical target document to be annotated. Evan discloses using an OCR device to capture a document image. (See Evans, Column 4, lines 48-58). Lee and Evans are analogous art because they are from the same field of endeavor of processing digital documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the optical image capture of Evans with the target document of Lee. The motivation for doing so would have been to be able to identify characters in the target

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document text by means of their coordinates and offsets. (See Evans, Column 4, lines 28-48). Therefore, it would have been obvious to combine Evans with Lee for the benefit of identifying individual characters within a target document to obtain the invention as specified in claims 7 and 16.

As per claims 8 and 17, Lee discloses the limitations of claims 1 and 9 as described above. Lee does not disclose expressly annotating one or more words in the target document using the same type of annotation as used in a source document from which stored words are derived. Evans discloses highlighting the text in a second document that corresponds to the highlighted text in a first document. (See Evans, Column 2, lines 1-14). Lee and Evans are analogous art because they are from the same field of endeavor of processing digital documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the highlighting annotations of Evans with the source and target documents of Lee. The motivation for doing so would have been to display in a visually distinct manner a region of the second document image that corresponds to the matching word in the first document so that the user may more easily identify a matched search term. (See Evans, Column 2, lines 15-18). Therefore, it would have been obvious to combine Evans with Lee for the benefit of easily identifying matching terms in a first and second document to obtain the invention as specified in claims 8 and 17.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Publication 2004/0088332 A1) as applied to claim 13 above, and further in view of Marshall (U.S. Publication 2003/0070139 A1).

As per claims 14 and 15, Lee discloses the limitations of claim 13 as described above. Lee does not disclose expressly detecting a type of annotation, and that the type of annotation includes one of highlighting, underlining, circling, crossing through, bracketing, bolding, italicizing, and coloring. Marshall discloses detecting the type of annotation, and that the type of annotation can include highlighting, which is set forth as one of the possible types of annotations possible in claim 15. (See Marshall, Page 3, paragraph 0038). Lee and Marshall are analogous art because they are from the same field of endeavor of processing digital documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the identification of the type of annotation and the use of highlighting as an annotation type of Marshall with the annotations of Lee. The motivation for doing so would have been to allow a user to identify valuable portions of a document using a high-value annotation type. (See Marshall, Page 3, paragraph 0038). Therefore, it would have been obvious to combine Marshall with Lee for the benefit of emphasizing an annotation to obtain the invention as specified in claims 14 and 15.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Publication 2004/0088332 A1) and Evans (U.S. Patent 6363179

B1) as applied to claim 4 above, and further in view of Marshall (U.S. Publication 2003/0070139 A1).

As per claims 5 and 6, Lee and Evans disclose the limitations of claim 4 as described above. Lee and Evans do not disclose expressly detecting a type of annotation, and that the type of annotation includes one of highlighting, underlining, circling, crossing through, bracketing, bolding, italicizing, and coloring. Marshall discloses detecting the type of annotation, and that the type of annotation can include highlighting, which is set forth as one of the possible types of annotations possible in claim 15. (See Marshall, Page 3, paragraph 0038). Lee, Evans and Marshall are analogous art because they are from the same field of endeavor of processing digital documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the identification of the type of annotation and the use of highlighting as an annotation type of Marshall with the annotations of Lee and Evans. The motivation for doing so would have been to allow a user to identify valuable portions of a document using a high-value annotation type. (See Marshall, Page 3, paragraph 0038). Therefore, it would have been obvious to combine Marshall with Lee and Evans for the benefit of emphasizing an annotation to obtain the invention as specified in claims 14 and 15.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Britton (U.S. Publication 2003/0018668 A1) discloses a method and system for improving the transcoding operations which are performed on structured documents through the use of annotations.
- Schilit (U.S. Patent 6,279,014 B1) discloses a method and system for organizing documents based upon annotations in context.
- Golovchinsky (U.S. Publication 2004/0078757 A1) discloses a system, apparatus and article of manufacture for detecting a reader's interest in a particular external document through their markings and annotations.
- Krause (U.S. Patent 6,154,757) discloses an electronic text reading environment enhancement method and apparatus.
- Van Hoff (U.S. Patent 5,822,539) discloses a system for adding requested document cross references to a document by annotation proxy.
- Bruggemann-Klein discloses a method for searching bibliographic databases using annotated content-based relations.
- Ginsburg discloses a knowledge management support system for document collections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is currently (703) 605-1238. After mid-October, 2004, the examiner can be reached at (571) 272-4095. The examiner can normally be reached on Monday-Friday from 7:00am to 3:30pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LAR



SANJIV SHAH
PRIMARY EXAMINER